

**Remarks**

Applicants have amended Claims 1, 16 and 17. Applicants respectfully submit no new matter has been added by the present amendment. Applicants acknowledge Claims 16 and 17 would be allowable if rewritten to include the limitations of Claim 1.

**Claim Rejection under 25 U.S.C. § 112, second paragraph**

Claims 1 and 7-17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended Claim 1 to recite a halobutyl elastomer and a "resulting ...halobutyl elastomer" at line 4. Applicants submit the amendment to Claim 1 placed Claims 1 and 7-17 in compliance with 35 U.S.C. § 112, second paragraph and accordingly Applicants request withdrawal of this ground of rejection.

**Claim Rejection under 35 U.S.C. § 102(b)**

Claims 1 and 7-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kondo et al. (U.S. Patent No. 5,393,816). Applicants respectfully traverse this ground of rejection.

Applicants submit to anticipate a claim, the cited references must teach each and every element of the claimed invention, either explicitly or inherently. Applicants submit the present invention is directed to a process for preparing a filled halobutyl elastomer comprising admixing a halobutyl elastomer, particles of filler and an additive **and curing** the resulting filled halobutyl elastomer, wherein the additive is an aminoalcohol, wherein the filled halobutyl elastomer consists essentially of a halobutyl elastomer, particles of filler, an additive, a curing agent and optionally an additional elastomer. Applicants submit Kondo et al. does not teach each and every element of the claimed invention.

Kondo et al. is directed to a rubber composition for cleaning a metal mold. According to Kondo et al., the cleaning rubber article is composed of a non-vulcanized

Mo-6836

- 4 -

rubber article, having on the surface thereof a layer of a rubber composition for cleaning a metal mold. According to Kondo et al., the rubber article comprises a rubber, an aminoalcohol, a glycol, an adsorptive and if desired, an organic silane. This combination, as noted in the Examples, results in an increased metal mold cleaning effect.

The rubber composition of Kondo et al. includes 5-50 parts by weight of a glycol. Whereas the present invention is directed to a process to prepare a filled halobutyl elastomer consisting essentially of a halobutyl elastomer, a filler, an additive, a curing agent and optionally another elastomer. Accordingly, the present invention does not include the addition of a glycol as taught by Kondo et al. Accordingly, Applicants submit Kondo et al. fails to anticipate the present invention.

#### **Claim Rejection under 35 U.S.C. § 103(a)**

Claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kondo et al. Applicant respectfully traverses this ground of rejection and submits that the present claims are patentable in view of the cited document.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (Fed. Cir. 1974)". Applicants also respectfully submit that "in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claims limitations. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure." See MPEP § 2142, citing In re Vaeck, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

Applicants incorporate their comments from above.

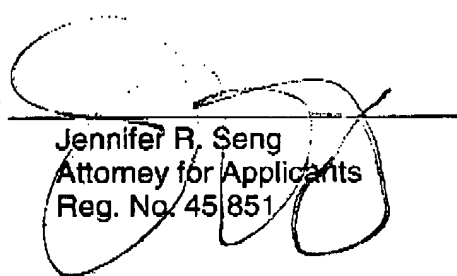
As discussed above, Kondo et al. does not teach the present invention and Applicants further submit Kondo et al. does not suggest the present invention either. As discussed above, the disclosed rubber composition in Kondo et al. includes glycol and is useful for cleaning rubber molds when the rubber composition comprises an aminoalcohol and a glycol, along with the other preferred ingredients. Whereas the present inventive process does not include the admixing of glycol.

Further, Applicants submit Kondo et al. fails to suggest admixing an aminoalcohol with a halobutyl elastomer to prepare a filled halobutyl elastomer with improved physical properties such as abrasion resistance and tensile properties.

Based at least on these comments, Applicants submit Kondo et al. fails to render the present process obvious.

Respectfully submitted,

By



Jennifer R. Seng  
Attorney for Applicants  
Reg. No. 45,851

LANXESS CORPORATION  
Law & Intellectual Property Department  
111 RIDC Park West Drive  
Pittsburgh, Pennsylvania 15275-1112  
(412) 809-2233  
FACSIMILE PHONE NUMBER:  
(412) 809-1054

\\srAS:\Law Shared\SHARED\JRS\PATENTS\6836\Response as filed 2-10-06.doc